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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/702,112	10/30/2000	Michael Gottlieb Jensen	1778.1730000	8333

26111 7590 05/20/2004

STERNE, KESSLER, GOLDSTEIN & FOX PLLC  
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WASHINGTON, DC 20005

EXAMINER

ELLIS, RICHARD L

ART UNIT	PAPER NUMBER
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2183

13

DATE MAILED: 05/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b> 09/702,112	<b>Applicant(s)</b> JENSEN ET AL.	
	<b>Examiner</b> Richard Ellis	<b>Art Unit</b> 2183	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
    a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>4, 5, 10</u> . | 6) <input type="checkbox"/> Other: ____.  |

1. Claims 1-35 remain for examination.
2. The text of those sections of Title 35, US Code not included in this action can be found in a prior Office Action.
3. In response to applicant's indication that one of the PTO-1449 information disclosure forms was not provided in the packet accompanying the rejection mailed November 14, 2003, a copy of all PTO-1449 forms present in the application is being provided with this office action. In this way, applicant can be assured of having at least one copy of all PTO-1449 forms present in the application.
4. Claims 1-35 are rejected under 35 USC § 103 as being unpatentable over Larsen et al., U.S. patent 5,115,500, in view of Heene et al., U.S. Patent 4,802,119.  
Larsen et al. and Heene et al. were cited as a prior art reference in paper number 6, mailed November 14, 2003.
5. The rejections are respectfully maintained and incorporated by reference as set forth in the last office action, paper number 6, mailed November 14, 2003.
6. Applicant's arguments filed April 14, 2004, paper number 12, have been fully considered but they are not deemed to be persuasive.
7. In the remarks, applicant argues in substance:
  - 7.1. That: "Heene does not teach or suggest "a plurality of boundary address registers for storing boundary addresses that partition the address space into a plurality of address ranges corresponding to the plurality of ISA decoding modes," as required by claim 1."

This is not found persuasive because applicant is arguing against the references individually. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this case, applicant is arguing that Heene et al. does not show boundary registers corresponding to plural ISA decoding modes. Heene et al. was not relied upon to show memory boundaries corresponding to ISA decoding modes, because Larsen et al. taught that

feature. Heene et al. was relied upon to add boundary registers corresponding to Larsen et al.'s disclosed fixed boundaries, allowing Larsen et al.'s boundaries to be variable. A modification that Larsen et al. himself suggested at col. 2, lines 28-35.

7.2. That: "In addition, Heene's PABL1, PABL2, PABL3, PABL4 registers "would not be included in the normal memory map of the MCU, but would appear only when the MCU is in special boot or special test mode" (see Heene, col. 5, lines 44-47). Thus, the combination of Larsen and Heene would result in a system in which the address registers would, upon a special boot or test mode, mark the start of a replacement block of memory of a definite size."

This is not found persuasive because applicant is arguing that Heene et al.'s system cannot be bodily incorporated into Larsen et al. This is improper, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). In this case, the combination of Larsen et al. and Heene et al. was not to mindlessly move Heene et al.'s registers into Larsen et al.'s system, but to move Heene et al.'s teachings of updatable/adjustable boundaries into Larsen et al.'s system, thereby making Larsen et al.'s system more flexible. Such modification was itself suggested by Larsen et al. at col. 2, lines 28-35.

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR § 1.136(a). The practice of automatically extending the shortened statutory period an additional month upon the filing of a timely first response to a final rejection has been discontinued by the Office. See 1021 TMOG 35.

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 CFR § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD

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FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS  
FINAL ACTION.

9. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Richard Ellis whose telephone number is (703) 305-9690. The Examiner can normally be reached on Monday through Thursday from 7am to 5pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Eddie Chan, can be reached on (703) 305-9712. The fax phone number for the USPTO is: (703)872-9306.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.



Richard Ellis  
May 18, 2004